

REMARKS

Claims 1-23 are all the claims pending in the Application. By this Amendment, Applicant amends claims 1 and 10 to further clarify the invention. In addition, Applicant adds claims 19-23.

I. Preliminary Matters

As preliminary matters, Applicant thanks the Examiner for acknowledging the claim to foreign priority and confirming that the certified copy of the priority documents was received. In addition, Applicant thanks the Examiner for accepting the drawings filed on April 2, 2001.

The Examiner has also initialed and returned Form PTO-1449 filed with Information Disclosure Statement filed on April 2, 2001. The Examiner, however, crossed out three of the references listed on the Form PTO-1449 alleging that they were not provided. Applicant respectfully provides another copy of the Form PTO-1449 and a PTO date-stamped copy of the filing receipt indicating receipt of the IDS and references to the Examiner along with a copy of the three references that were filed on April 2, 2000. Applicant respectfully requests that the Examiner initial all of the references listed on this form.

In particular, the Examiner should initial the references because the three references were provided (and a copy of these references are enclosed with the response) and the concise explanation requirement for foreign references under 37 C.F.R. § 1.98(a)(3) has also been satisfied. In particular, a concise explanation “may be either separate from the specification or incorporated therein with the page(s) and lines of the specification where it is incorporated being noted” MPEP § 609 (page 600-122). Information Disclosure Statement filed on April 2, 2001 explicitly stated that the cited reference are discussed within the Application (in the

Specification, on pages 2 and 4). Therefore, Applicant's duty of concise explanation has also been satisfied. It is thus appropriate and necessary for the Examiner to initial all references listed on Form PTO-1449.

II. Summary of the Office Action

Turning to the merits of the Office Action, claims 2-9 and 11-18 contain allowable subject matter and claims 1 and 10 are rejected under 35 U.S.C. § 102(b).

III. Prior Art Rejection

Next, with respect to the rejection, independent claims 1 and 10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,726,771 to Gann et al. (hereinafter "Gann").

Turning to the cited art, Gann teaches tonal resolution of an image scanner by adjusting the dynamic range of an analog-to-digital converter of the scanner. A preview scan of the image is made. The image data from the preview scan is then analyzed to determine a maximum intensity and a minimum intensity. The value of the maximum intensity is used to set a white intercept of the image scanner such that a maximum digital value of the analog-to-digital converter corresponds to the maximum intensity present in the image data from the preview scan. The minimum intensity is used to set a black intercept of the image scanner such that the minimum intensity in the image data from the preview scan corresponds to the minimum digital number output by the analog-to-digital converter. Tonal resolution of the image scanner is optimized then by performing a final scan of the image with the analog-to-digital converter programmed to reflect the new white intercept and black intercept values (Fig. 3, col. 5, lines 48 to col. 6, line 35).

The Examiner contends that Gann suggests each feature of independent claims 1 and 10. This rejection is not supportable for at least the following reasons. First, claim 1 recites: “carrying out pre-reading prior to the main reading; analyzing the electric signal obtained by the pre-reading; determining a normalization processing characteristic...carrying out the normalization processing on the electric signal obtained by the main reading, based on the normalization processing characteristic that has been determined, wherein, in the pre-reading, some of the electric charges to be read out during the main-reading are read out.”

Gann teaches performing a preview scan to obtain maximum and minimum reflectance of the image light. The intensities from the preview scan are then analyzed to obtain white and black intercept for the image capture system 100. Using these set intercepts, the final scan is performed, and then processing is performed on the image obtained with the final scan (col. 6, lines 16 to 35). Gann, however, uses the intensities obtained by the preview scanning in performing the final scan and not in the processing of the image obtained with the final scan. In other words, the intensities are obtained to facilitate the final scan and not for the processing. That is, in Gann, the values obtained by pre-scanning are used for the final scan and not for the processing of the image obtained from the final scan.

In summary, the deficiencies of the Gann reference fall to the Examiner’s burden to show inherent inclusion of the claim elements. Therefore, for all the above reasons, independent claim 1 is patentable.

With respect to claim 10, it recites limitations similar to the limitations argued above with respect to claim 1. Since claim 10 contains features that are similar to the features argued above with respect to claim 1, those arguments are respectfully submitted to apply with equal force

here. For at least substantially the same reasons, claim 10 is patentably distinguishable from Gann.

In addition, with respect to claim 10, the Examiner only indicated that analogous arguments to the ones presented for claim 1 are applicable to claim 10 (see page 2 of the Office Action). Claim 10, however, also recites: control means for controlling switching between main reading in which the image information is read and pre-reading for obtaining the electric signal carried out prior to the main reading.

To be an “anticipation” rejection under 35 U.S.C. § 102, the reference must teach every element and recitation of the Applicant’s claims. Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Thus, the reference must clearly and unequivocally disclose every element and recitation of the claimed invention. Gann does not teach or suggest a control means that switch between the main reading and the pre-reading. For at least this additional reason, claim 10 is patentably distinguishable from Gann.

IV. Allowable Subject Matter

Claims 2-9 and 11-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claims and any intervening claims. Applicant respectfully holds the rewriting of these claims in abeyance until arguments presented with respect to independent claims 1 and 10 have been reconsidered.

V. New Claims

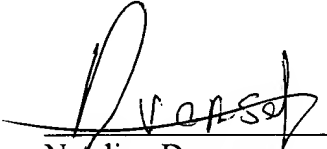
In order to provide more varied protection, Applicant adds claims 19-23.

VI. Conclusion and request for telephone interview

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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